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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/597,742	06/19/2000	J.Carr Bettis	26119.100 US1	3881

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EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT PAPER NUMBER

3624

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/597,742

Applicant(s)

BETTIS ET AL.

Examiner

Narayanswamy Subramanian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-39, 128 and 130 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-39, 128 and 130 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to applicant's communications filed on June 1, 2004 and July 23, 2004. Amendments to claims 21, 31, 128 and 130 and cancellation of claims 1-20, 40-127 and 129 have been entered. Rejections made under 35 USC § 101 and 35 USC § 112 second paragraph in the office action mailed on December 30, 2003 (Paper No. 10) are withdrawn by the Examiner in view of the amendments. Claims 21-39, 128 and 130 are currently pending and have been examined. The rejections and response to arguments are stated below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 21-39, 128 and 130 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fox (US Patent 5,132,899) in view of Basch et al (US Patent 6,119,103).

With reference to claims 21, 128 and 130, Fox teaches computer implemented methods and a computer implemented system for use in producing a ranked list of investors according to an evaluation of the investors' performances relating to at least one transaction made by the investors involving investments associated with the investors, said method comprising the steps of: retrieving a list of investors (See Fox Column 2 lines 41-52 and Claim 1); generating an evaluation list by removing investors failing to meet predetermined criteria from said list (See Fox Column 2 lines 41-52 and Claim 1); calculating, using a computer, a performance score for

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each investor listed on said evaluation list indicative of the investor's performance by considering an average historical performance of an investment following a transaction by the investor and a historical consistency of the investor's performances with respect to transactions involving the at least one investment (See Fox Column 2 lines 41-52, Column 4 lines 46-48 and Claim 1); and calculating, for each investor using said performance scores, a third data indicative of the investor's relative performance with respect to all investors on said evaluation list (See Fox Column 2 line 41- Column3 line 32, and Claims 1, 3, 4 and 6). Selectively generating a subset of managers based on predetermined criteria implies the step of generating an evaluation list by removing investors failing to meet predetermined criteria, the rate of return is a performance score and the beta and third data relating to a plurality of financial characteristics include the step of a final transaction score indicative of the investor's relative performance with respect to all investors on said evaluation list. Transaction by the investor is inherent in the disclosure, because only those stocks in which the managers have transacted will be considered in evaluating performance; average historical performance includes the rate of return after a single transaction (since the denominator for computing the average would be equal to one) and historical consistency is inherent in the disclosure (See Fox Column 4 lines 46-48).

Fox does not explicitly teach the step wherein a score considers the number of transactions made by a user.

Basch teaches the step wherein a score considers the number of transactions made by a user (See Basch Column 3 lines 56-59 and Column 19 lines 38-46).

Both Basch and Fox are concerned with the problem of scoring performances. It would have been obvious to one with ordinary skill in the art at the time of the current invention to

combine the disclosure of Basch to the teaching of Fox. The combination of the disclosures taken as a whole suggests that users will benefit from the accurate computation of performance scores that considers the number of transactions made by the investor.

With reference to claims 32-37 and 39, Basch and Fox combined disclose a method of claim 21 as discussed above. Fox does not explicitly disclose the steps of calculating the specific performance scores and related statistics listed in these claims. Basch discloses the steps of collecting relevant data, generating models using statistical methods and using the transaction data along with the models generated to generate scores (See Basch Figure 9, Column 11 line 38 – Column 12 line 54). The steps of collecting relevant data, generating models using statistical methods and using the transaction data along with the models generated to generate scores are interpreted to include the features in these claims. Hence it would have been obvious to one with ordinary skill in the art at the time of the current invention to include the disclosure of Basch to the teaching of Fox. The combination of the disclosures taken as a whole suggests that decision makers would have benefited from the refined objective inputs available to the decision maker by using these techniques.

Response to Arguments

4. In response to applicant's argument with respect to claim 21, made by the Applicants on pages 12-14 of their amendment received on June 1, 2004, that the Fox reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e. providing raw information and data but also usable for evaluating performance based on returns observed after decisions concerning buying and selling activity, historical consistency at picking entry and exit points and/or the number of buying and selling decisions made by the

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insider or investing entity”, “evaluating performance with respect to all insiders and/or traders, but also usable for evaluating performance with respect to insiders and/or traders in a particular industry”, “the present invention is able to provide information pertaining to the reliability of a particular insider’s or trader’s actions. Further, the present invention is able to optionally evaluate performance with respect to insiders and traders for specific industries”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's other arguments with respect to claims 21-39, 128 and 130 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

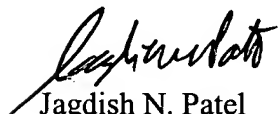
5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft or Informal faxes to the Patent Office is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

N. Subramanian
November 14, 2004

 11/15/04
Jagdish N. Patel
Primary Examiner